



20 SEP 2006

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In re Application of :
ANGOT *et al* :
U.S. Application No.: 10/537,550 :
PCT No.: PCT/FR03/03458 :
Int. Filing Date: 24 November 2003 :
Priority Date: 04 December 2004 :
Attorney Docket No.: 09471.0020 :
For: POLYAMINO ACIDS :
FUNCTIONALIZED BY AT LEAST ONE :
(OLIGO) AMINO ACID GROUP . . . :

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 09 June 2006.

BACKGROUND

On 02 December 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 30 March 2006, a Power of Attorney changing the attorney of record was filed along with a declaration executed by two of the three named inventors.

On 09 June 2006, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a declaration signed by two of the three named inventors; a statement of facts by Charles Marlio; documentary evidence in French; and authorization to charge all required fees to Deposit Account No. 50-2228.

DISCUSSION

Applicants claim that co-inventor, Gerald Soula refuses to cooperate and have filed the subject petition. The five-month extension fee and surcharge fee has been charged to Deposit Account No. 50-2228 as authorized.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuse to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath

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or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Concerning item (1), the petition fee has been paid.

With regards to item (3), the last known address of co-inventor Gerald Soula is listed as:

33 rue Nungesser.
69330 Meyzieu
France

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by two of the three named co-inventors on behalf of themselves and the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Regarding item (2), applicants' burden in showing that an inventor refuses to cooperate is explained in section 409.03(d) of the MPEP. Several pertinent segments are listed below:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . .

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning

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inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Here, counsel states that a copy of the assignment and declaration were sent to the last known address for Mr. Soula. However, applicants must also show that a complete copy of the application (specification, claims and drawings) were sent to the nonsigning inventor for the refusal to be accepted. The statement by Charles Marlio is not sufficient to meet the requirements of the MPEP. Moreover, the documentary evidence submitted to show a refusal is in a foreign language and will not be accepted without an accompanying English translation.

For this reason, item (2) of 37 CFR 1.47(a) is not satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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